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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,445

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Benjamin T. Golding

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

STRODER, CARRIE A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,445	Applicant(s) GOLDING ET AL.	
	Examiner CARRIE A. STRODER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 10 November 2005, wherein:

Claims 1-18 are currently pending.

Claim Objections

1. **Claims 1-18 are objected to** because of the following informalities: numbers corresponding to the drawings should not be included in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 9-16 are rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 9 invokes 35 USC 112 when stating, "transceiver means for transmitting and receiving messages". However, the specification does not describe adequate structure for

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performing the recited function. The specification, on page 6 refers to a "radio unit"; however, this is not sufficient structure to satisfy the requirements under 35 USC 112.

Claims 9 and 13 invoke 35 USC 112 when stating, "means for establishing a product intranet according to the blueprint". However, the specification does not describe adequate structure for performing the recited function. Page 9, lines 11-27 of the specification appears to describe a method for the establishing.

Claim 13 invokes 35 USC 112 when stating, "transceiver means for receiving a product intranet blueprint". However, the specification does not describe adequate structure for performing the recited function. The specification, on page 6 refers to a "radio unit"; however, this is not sufficient structure to satisfy the requirements under 35 USC 112.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 used the word "substantially"

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which is vague and indefinite. The metes and bounds of the claim are not clear.

5. **Claims 9-16 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no structure described in the specification which corresponds to the claim limitations, "transceiver means for transmitting and receiving messages," "means for establishing a product intranet according to the blueprint," and "transceiver means for receiving a product intranet blueprint". If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph. MPEP 2181.

6. **Claim 12 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 states that it is directed to "an electronic product in accordance with any of the methods as claimed in claim 1," which is vague and indefinite. It is not clear whether claim 12 is dependent on claim 1. Secondly, "any of the methods" implies that claim 1 has multiple methods, which is confusing.

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Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 and 13-18 are rejected under 35 U.S.C. § 101

because the claimed invention is directed to non-statutory subject matter.

Referring to claims 1-8, in order for a method to be considered a "process" under §101, a claimed process must either: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the "machine or- transformation test". In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process.

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This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

With respect to claims 1-8, the claim language does not include the required tie to a particular machine or apparatus or transformation and thus is directed to nonstatutory subject matter. The first element of claim 1, "providing a...blueprint..." could be interpreted as just a piece of paper, which does not provide the required tie or transformation. The second element could involve simply choosing an item from a picture, which, again, does not provide the required tie or transformation. The third and final element is insignificant post-solution activity.

Claims 13-18 are directed to software, per se, which is not patentable subject matter. SEE MPEP 2106.01. Claim 13 refers to an "electronic module" which could be interpreted as software.

Claims 17-18 refer to a "product intranet blueprint" which is interpreted as either software or a piece of paper. Either way, it is non-statutory as it is not a process, machine, manufacture, or composition of matter.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-5, 8-9, 12-13, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haulin et al. (US 20060179128).**

Referring to claim 1:

Haulin teaches

providing a product intranet blueprint describing modules required for the product (paragraphs 33-38; "The first digital storage unit M1 is adapted to hold information pertaining to accomplishment of a primary function of the communication module CM.sub.1, such as receiving incoming data traffic, performing switching operations and transmitting outgoing data traffic. For this purpose, the first digital storage unit M1 may contain software code, firmware code and/or control parameters." and where it is implied that the code included with the product

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contains information describing the required parts for the product),

selecting modules for the product including a primary module based on a modules respective description data and the product blueprint (paragraph 33; "FIG. 1 shows a communication module CM.sub.1, which is connected to a node 110 of a communications network 140 according to an embodiment of the present invention. A central resource 120, such as a management system server, is also connected to the network 140. In addition to the module CM.sub.1, the node 110 includes a plurality of similar communication modules" and where it is implied that the modules are selected based on its capabilities and the product blueprint), and

establishing a product intranet comprising said selected modules and by which intranet said product at least in part operates (paragraph 38; "According to the invention, the bi-directional wireless interface I.sub.w is adapted to provide a local wireless access to the first digital storage unit M1.").

Referring to claim 2:

Haulin teaches wherein said product blueprint further includes product program code for said primary module, and wherein said blueprint is uploaded to the primary module prior to establishing said product intranet (paragraphs 33-38; "For

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this purpose, the first digital storage unit M1 may contain software code, firmware code and/or control parameters." and where it is implied that the code is uploaded prior to establishing the product intranet).

Referring to claim 3:

Haulin teaches wherein the modules include unique identifiers and wherein the establishing of said product intranet comprises the primary module wirelessly exchanging a network identifier with the identifiers of the other selected modules to register said modules (paragraphs 38-40; "In practice, this means that a portable software carrier unit 130 (for instance in the form of a personal digital assistant, a palmtop computer, a laptop computer or a mobile telephone) may wirelessly exchange information with the first digital storage unit M1." and "...the authorization signal S.sub.A may include a unique identifier...").

Referring to claim 4:

Haulin teaches wherein the selected modules are arranged within a shielded area prior to establishing said intranet to ensure only selected modules are included in said intranet (paragraph 12; "A communication node, such as an optical transceiver, is normally placed inside an electromagnetic shielded cabinet in order to protect the units therein from

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interference with external radio signals. Such shielding typically renders an alternative wireless access impossible, for instance by means of a radio interface." and further, *to ensure only selected modules are included in said intranet* is not a positive claim limitation and therefore, receives little patentable weight).

Referring to claim 5:

Haulin teaches wherein the modules are arranged substantially within a product housing following said selecting (paragraph 38; "...personal digital assistant, a palmtop computer, a laptop computer, or a mobile telephone..." implies that the modules are arranged within a product housing and where, for example, the computer may have been purchased and built after having been selected to be part of the network).

Referring to claim 8:

Haulin teaches wherein said product housing comprises shielding which restricts the range of the intranet to substantially within said housing (paragraph 12; "A communication node, such as an optical transceiver, is normally placed inside an electromagnetic shielded cabinet" and where "cabinet" is interpreted as *housing*).

Referring to claim 9:

Haulin teaches

a housing having a plurality of electronic modules each having transceiver means for transmitting and receiving messages, and wherein at least one of the modules is a primary module having (paragraph 38; "...portable software carrier unit 130 (for instance in the form of a personal digital assistant, a palmtop computer, a laptop computer or a mobile telephone) may wirelessly exchange information with the first digital storage unit M1" implies that the modules are arranged within a product housing);

means for storing a product intranet blueprint (paragraph 34; "...the first digital storage unit..."); and

means for establishing a product intranet according to the blueprint (paragraph 38; "According to the invention, the bi-directional wireless interface I.sub.w is adapted to provide a local wireless access to the first digital storage unit M1.").

Further, "a housing having a plurality of electronic modules each having transceiver means for transmitting and receiving messages, and wherein at least one of the modules is a primary module having," and "means for establishing a product intranet according to the blueprint" lack structure. As claim 9 is an apparatus claim, these limitations do not further limit the apparatus, and therefore, receive little patentable weight.

Referring to claim 12:

Haulin teaches an electronic product manufactured in accordance with any of the methods as claimed in claim 1 (paragraphs 33-38; "The first digital storage unit M1 is adapted to hold information pertaining to accomplishment of a primary function of the communication module CM.sub.1, such as receiving incoming data traffic, performing switching operations and transmitting outgoing data traffic. For this purpose, the first digital storage unit M1 may contain software code, firmware code and/or control parameters.").

Referring to claim 13:

Haulin teaches
transceiver means for receiving a product intranet blueprint (paragraph 38; "...portable software carrier unit 130 (for instance in the form of a personal digital assistant, a palmtop computer, a laptop computer or a mobile telephone) may wirelessly exchange information with the first digital storage unit M1"),

storage means for storing module description data and for storing said blueprint (paragraph 34; "...the first digital storage unit..."),

means for establishing a product intranet in accordance with said blueprint (paragraph 38; "According to the invention,

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the bi-directional wireless interface I.sub.w is adapted to provide a local wireless access to the first digital storage unit M1.").

Further, "transceiver means for receiving a product intranet blueprint" and "means for establishing a product intranet according to the blueprint" lack structure. If claim 13 is interpreted as an apparatus claim, these limitations do not further limit the apparatus, and therefore, receive little patentable weight.

Referring to claim 15:

Haulin teaches a keypad part (paragraph 38; "...portable software carrier unit 130 (for instance in the form of a personal digital assistant, a palmtop computer, a laptop computer or a mobile telephone) may wirelessly exchange information with the first digital storage unit M1" and where a PDA, computer, and telephone all include keypads).

Referring to claim 16:

Haulin teaches a display part (paragraph 38; "...portable software carrier unit 130 (for instance in the form of a personal digital assistant, a palmtop computer, a laptop computer or a mobile telephone) may wirelessly exchange information with the first digital storage unit M1" and where a PDA, computer, and mobile telephone all include keypads).

Referring to claim 17:

Haulin teaches data describing module requirements for said product (paragraphs 33-38; "The first digital storage unit M1 is adapted to hold information pertaining to accomplishment of a primary function of the communication module CM.sub.1, such as receiving incoming data traffic, performing switching operations and transmitting outgoing data traffic. For this purpose, the first digital storage unit M1 may contain software code, firmware code and/or control parameters." and where it is implied that the code included with the product contains information describing the required parts for the product).

Referring to claim 18:

Haulin teaches product function code for operating the product (paragraphs 33-38; "For this purpose, the first digital storage unit M1 may contain software code, firmware code and/or control parameters.").

5. Claims 6-7, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haulin et al. (US 20060179128), in view of Lau (US 6690657).

Referring to claim 6:

Haulin does not teach; however, Lau teaches wherein the transmit power of the modules is decreased to restrict the range of the product intranet (col. 3, line 60 thru col. 4, line 5;

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"in a localized wireless network, lower power and shorter range can be desirable attributes, as they decrease harmful interference with neighbors and unintended recipients, increase security and isolation, and allow for smaller, simpler transceiver designs.").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Haulin as taught by Lau because this would decrease interference with other electronic products.

Referring to claim 7:

Haulin does not teach; however, Lau teaches wherein the range of the intranet is between one centimetre and one metre (col. 6, lines 53-67; "...path of a few meters..." implies that the range may include up to one meter).

Further, the range is a design choice. It would have been obvious to a person having ordinary skill in the art at the time of invention to choose a range between one centimeter and one meter, so as to decrease electronic interference with other electronic products.

Referring to claim 10:

Haulin does not teach; however, Lau teaches further comprising control means for controlling the power output by said transceiver means (col. 3, line 60 thru col. 4, line 5; "in

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a localized wireless network, lower power and shorter range can be desirable attributes, as they decrease harmful interference with neighbors and unintended recipients, increase security and isolation, and allow for smaller, simpler transceiver designs." implies controlling the power output).

Referring to claim 14:

Haulin does not teach; however, Hau teaches further comprising control means for controlling said transceiver means to limit the range over which said intranet operates (col. 3, line 60 thru col. 4, line 5; "in a localized wireless network, lower power and shorter range can be desirable attributes, as they decrease harmful interference with neighbors and unintended recipients, increase security and isolation, and allow for smaller, simpler transceiver designs.").

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haulin et al. (US 20060179128), in view of Lau (US 6690657), and further in view of Feezor (US 3793484).

Referring to claim 11:

Haulin and Lau do not teach; however, Feezor teaches wherein said control means further comprise a programmable attenuator (col. 1, lines 44-59; "...programmable attenuator...").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the

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teachings of Haulin and Lau as taught by Feezor because this would provide a manner in which to control the power output, thereby increasing battery life and reducing electronic interference with other electronic components.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Ast et al. (US 5412414);
- b. Simmons et al. (US 5339222);
- c. Beghelli (US 5459450);
- d. Bowman-Amuah (US 7289964);
- e. Curry et al. (US 20020030094);
- f. Schweidler et al. (US 7580420);
- g. Walker et al. (US 20030064807); and
- h. Jacobsen et al. (US 20040108848).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be

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reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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